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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,772	03/08/2005	Andreas Rinke	41653-210807	2214
26694	7590	09/13/2007		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER DESAI, HEMANT	
			ART UNIT	PAPER NUMBER
			3721	
			MAIL DATE	DELIVERY MODE
			09/13/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/526,772	RINKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hemant M. Desai	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18,19,21,23-29,32-36,38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,19,21,23-29,32-36,38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-19, 21, 23-29, 32-36, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims contain that "during the continuous transport of the filter rods or filter segments while the filter rods or filter segments are positioned on a conveying drum or operating drum thereby preventing any interruption of the continuous filter-production operation" (Claim 18, lines 9-12 and claim 29, lines 7-8, emphasis added). In the drawings and specification it is not shown or explained how the injecting means (2 or 5) is injecting the medium in the filter rods during the continuous transport of the filter rods or filter segments while the filter rods or filter segments are positioned on a conveying drum or operating drum. Because if the injecting means (2 or 5) is injecting the medium in the filter rods during the continuous transport of the filter rods or filter segments while the filter rods or filter segments are positioned on a conveying drum, than the injecting means must be synchronously moving with the conveying drum or operating drum. In the drawing and specification only reciprocating movement of the injecting means (2, 5) is shown. In that case

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conveying drum or operating drum has to stop during the injection of medium by the nozzle or spray needle. And therefore, it is not the "continuous filter-production operation".

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 18-19, 21, 23-29, 32-36, 38 and 39 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "during the continuous transport of the filter rods or filter segments while the filter rods or filter segments are positioned on a conveying drum or operating drum thereby preventing any interruption of the continuous filter-production operation" (Claim 18, lines 9-12 and claim 29, lines 7-8) is vague, confusing and indefinite, because it is not understood how applicant is injecting the medium in the filter rod with out interrupting the rotation of the drum since the injecting nozzle or spray needle is moving reciprocally only. The injecting nozzle or spray needle is not moving synchronously (rotational movement) with the drum.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 18-19, 21, 23-29, 32-36, 38 and 39 are rejected under 35

U.S.C. 102(b) as being anticipated by Hemming et al. (3485208).

Hemming et al. disclose a method for producing filters in the tobacco-processing industry comprising delivering filter rods (2, fig. 1) to form a group of filter segments, and introducing a medium (see col. 3, lines 26-35) to the filter rods before completion of the delivering step.

Regarding claim 19, Hemming et al. disclose that the method comprising step of delivering additional filter rods to the formed group of filter segments.

Regarding claim 21, Hemming et al. disclose that the delivering step includes transporting the filter rods from a magazine (1, fig. 1) to a module and introducing the medium in the filter rods during the transporting step.

Regarding claim 23, Hemming et al. disclose that the filter rods are held in place before the medium is introduced.

Regarding claim 24, Hemming et al. disclose that a predetermined amount of the medium is introduced (see col. 4, lines 1-4).

Regarding claim 25, Hemming et al. disclose that the medium is introduced by an element for injecting the filter rod to the outside of the filter rod.

Regarding claim 26, Hemming et al. disclose that the element is an injection needle (30-33, fig. 2).

Regarding claim 27, Hemming et al. disclose that the medium is introduced parallel to the longitudinal axial direction of the filter rods.

Regarding claim 28, Hemming et al. disclose that the medium is introduced into at least one hollow space in a multi-filter segment.

Regarding claim 29, Hemming et al. disclose a module, wherein filter rods (2, fig. 1) can be delivered to form a group of filter segments and a device (13-16, 30-33, fig. 2) is provided for introducing a medium into the filter rods.

Regarding claim 32, Hemming et al. disclose that the module comprises a holding element (34, fig. 1) for holding the filter rods against the operating drum.

Regarding claim 33, Hemming et al. disclose that the device comprises a spray needle (30-33, fig. 2) for introducing the medium to the filter rods.

Regarding claim 34, Hemming et al. disclose that the injection element is subjected to pressure by a compressed-air piston (14, fig. 1).

Regarding claim 35, Hemming et al. disclose that a metering device is provided (see col. 4, lines 1-3) for the medium.

Regarding claim 36, Hemming et al. disclose a filter maker in the tobacco-processing industry.

Regarding claim 38, Hemming et al. disclose that the medium is introduced into the interior of the filter segments or the filter rods from outside the interior by means of an introduction member.

Regarding claim 39, Hemming et al. disclose that the introduction member is a spray nozzle.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-19, 21, 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colburn et al. (2548948) in view of Hemming et al. (3485208).

Colburn et al. disclose an apparatus for treating tobacco articles and particularly for applying a liquid solution to the end of the cigarettes" (column 1, lines 2-4). As shown in the drawings, the conveyor comprises a belt provided with a plurality of peripheral seats for accommodating respective articles and for conveying the articles along a path extending through a inserting station where are disposed two fluid dispensing devices, which are arranged on opposite sides of the belt so as to "engage, treat and then recede from the opposite sides of the articles while the latter are continuously moving" (column 5, lines 14-16). Each fluid dispensing devices comprise an injector comprising "a cylinder which is provided with a piston and a reduced conical end terminating in a discharge orifice" (column 4, lines 4-7), arranged for introducing the medium longitudinally parallel to the axis of the articles. The device further comprises an holding device in the form of a plurality of bristles, which are coupled with the orifices for "engage and penetrate the ends of the cigarettes" in order to "maintain the cigarettes in proper treating relation relative to the fluid dispensing means" (column 4, lines 10, 15, 16). Furthermore, the cylinder and the piston as a whole define a metering device (see column 4, lines 65-70) arranged to introduce a predetermined amount of medium into the cigarettes.

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Colburn et al., as mentioned above, disclose to introducing medium to cigarettes. Colburn et al. do not disclose to introduce medium to the filter segments or filter rods. However, Hemming et al. disclose that it is well known in the tobacco art to introduce medium to the filter segments or filter rods. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method and module of Colburn to treat filter segments or filter rods as taught by Hemming et al.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colburn et al. and Hemming et al. as applied to claim 18 above, and further in view of Keritsis (5115823).

The modified method and module of Colburn et al., as mentioned above, discloses all the claimed limitations of claim 28, except the medium is in introduces into a multi-filter segment. However, Keritsis discloses a smoking filter having two zones, including one central filtering zone and one flavor-enhancing zone surrounding the central zone. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the method of Colburn to treat the multi-filter segment of Keritsi.

9. Claims 29, 32-36 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1016350 and Keritsis (5115823) and further in view of Colburn et al. (2548948).

EP 1016350 discloses a machine for combining groups of filter segments for producing multi-segment filters of the tobacco industry in a continuous process. The multi-segment filters are obtained by inserting different filter



segments, which are processed along separate feed paths, successively between two rods of tobacco. As clearly shown in figure 1, the feed paths are operatively autonomous from one another and define independent functional units, for this reason each feed path can be regarded in every respect as a module. Each feed path comprises a respective supply for the filter segments and a respective plurality of processing drums for cutting apart, grouping and inserting the segments between the tobacco rods.

EP 1016350 discloses the machine for continuous producing multi-segment filters of the tobacco industry in a continuous process. Keritsis discloses that it is well known in the tobacco art to add medium to multi-segment filters to significantly enhance the flavor of smoke produced from a burning tobacco (see col. 2, lines 22-25). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the medium to the multi-segment filters of the EP 1016350 to significantly enhance the flavor of smoke produced from a burning tobacco.

The modified module of EP 1016350 meets all the limitations except, for an apparatus to apply a treating solution (medium) to multi-segment filters while they are continuously moving. However, Colburn et al. disclose that it is well known in the tobacco art to apply a treating solution (medium) to cylindrical objects while they are continuously moving. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a medium to the filter segments during a continuous process, would have

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considered the apparatus of Colburn et al. to apply a treating solution to articles while the articles are continuously moved on a conveyor.

***Response to Arguments***

10. Applicant's arguments with respect to claims 18-19, 21, 23-29, 32-36 and 38-39 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

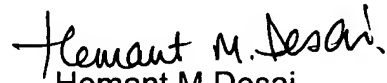
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant M. Desai whose telephone number is

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(571) 272-4458. The examiner can normally be reached on 6:30 AM-5:00 PM, Mon-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Hemant M Desai  
Primary Examiner  
Art Unit 3721

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